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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,730	01/24/2001	Steve Buckley	YOR92000694US1	2263

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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,730

Applicant(s) **SW**

BUCKLEY ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-17 (method), 18-22 (method), 35-42 (a machine readable medium) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

2. In the present case, claims 1-17 are directed to "A method of providing business solutions over an interactive communication medium", which is not within one of the classes of invention set forth in § 101.

The "A method of providing business solutions over an interactive communication medium" comprising the steps of (a) selectively providing metrics ... industry, (b) providing a business solution ..., as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "A method of providing business solutions over an interactive communication medium" comprising the steps of (a)-(b) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (computer/computer automation/computer network, etc.) and are therefore are found to be non-statutory.

See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ

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430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

3. In the present case, claims 18-22 are directed to “A method of providing business solutions over an interactive communication medium”, which is not within one of the classes of invention set forth in § 101.

The “A method of providing business solutions over an interactive communication medium” comprising the steps of (a) identify a specific industry, (b) ..., (c), and (d) providing a business solution, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The “A method of providing business solutions over an interactive communication medium” comprising the steps of (a)-(b) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (computer/computer automation/computer network, etc.) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

4. In the present case, claims 35-42 are directed to “A machine readable medium containing code for providing business solutions over an interactive communication medium”, which is not within one of the classes of invention set forth in § 101.

The “A machine readable medium containing code for providing business solutions over an interactive communication medium” comprising the steps of: (a)

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selectively providing metrics ... industry, (b) providing a business solution ..., as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "A machine readable medium containing code for providing business solutions over an interactive communication medium" comprising the steps of (a)-(b) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (computer/computer automation/computer network, etc.) and are therefore are found to be non-statutory. See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-16, 23-28, 29-34, 35-42 are rejected under 35 U.S.C. 102(a) as being anticipated by FRIEDMAN (US 6,591,256).

As for claim 1, FRIEDMAN discloses a method for providing business solutions over an interactive communications medium, comprising the steps of: (a) selectively providing metrics (questions) which are associated with a business problem and a specific industry; and (b) providing a business solution based on the selective metrics

and responses to the selective metrics (see Figs. 1, 2, col. 3, lines 1-20 or [3:1-20]), 4:45-65).

As for claims 2-4, these are taught on Figs. 2-3, 4:45-65. As for claim 5, the use of database to store information and set of rules, expert system, knowledge based system, etc., to solve questions/issues are well known and are taught in Figs. 1, elements 15, 40 (database), 50 (expert system), Figs. 7-8, 4:45-60, 6:30-60. As for the limitation of quality of the answer "transparent" in claim 6, this is inherently included in the teaching of FRIEDMAN because FRIEDMAN fairly teaches the concept of using the "correct problem solving" software to provide the solution correctly or clearly for the user "clear and simple", see [1:50-55, 3:25-35].

As for the use of "ranking rules" in claim 7, this is taught in Fig. 5, Fig. 7, [5:45-65] which deals with degree of sensitivity. As for claims 8-10, these are taught in Figs. 2-3, which deal with issues such as inventory, cost, resource allocation, or forecasting, etc. As for claims 11-14 which deals with use of previous questions and answers in the rules based, these are inherently included in the Expert system of FRIEDMAN wherein FRIEDMAN discloses the use of different models such as "sequential policy problems", generic model, or queuing theory, etc., (see Fig. 2, [4:15-60]). As for claim 15, this is shown in Figs. 5-7. As for claim 16, this is shown on Fig. 7, "cost table complete" or [6:15-30, 55-62].

As for claim 23, it is rejected over the means to carry out the steps of claim 1 which is taught in FRIEDMAN as shown in the rejection of claim 1. As for claim 24, it's rejected for the same reason as in claim 2 above. As for claims 25-27, they are rejected

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for the same reasons set forth in claim 5 above. As for claim 28, it's rejected for the same reason set forth in claim 16.

As for claim 29, it is rejected over the means to carry out the steps of claims 1 and 2 which are taught in FRIEDMAN as shown in the rejections of claims 1 and 2. As for claim 30, it's rejected for the same reason as in claim 15 above. As for claim 31, it's rejected for the same reasons set forth in claim 16 above. As for claim 32, this is taught in FRIEDMAN col. 4, lines 45-65, col. 3, lines 5-20. As for claim 33, it's rejected for the same reason set forth in claim 15. As for claim 34, this is shown in Fig. 1.

As for the machine readable medium containing code in claims 35-42 for carrying out the method claims of claims 1, 2, 4, 7, 8, 12, 15, 16, respectively, they are rejected for the same reason set forth in claims 1, 2, 4, 7, 8, 12, 15, and 16, respectively.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-14 (2nd time), 17, 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over FRIEDMAN.

As for claims 11-14, FRIEDMAN discloses the optimization of specific problem Parameters or variables and different rules based model on Figs. 2-3, col. 4, lines 10-40, col. 6, lines 45-62. The use of other similar or equivalent mathematical model or rules based would have been obvious as mere using other similar or equivalent model

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or rules to achieve similar results. Note that on Figs. 2-4, FRIEDMAN fairly teaches the concept of optimization of the desired business parameters, i.e. resource allocation, direct transportation cost, network problems, inventory, sequential policy, generic model, queuing theory, etc.

As for claim 17, FRIEDMAN fairly teaches results of financial analysis such as maximum profits, minimum cost, cost table complete, assignment cost, forecasting, mortgage calculation, etc. The use of other well known financial analysis variable such as ROR, ROI, ROA, etc., would have been obvious if desired.

As for claim 18, it's rejected for the same reasons set forth in claim 1 and 16-17 above. As for claim 19, it's rejected for the same reason set forth in claim 5. As for claim 20, it's rejected for the same reason set forth in claim 7. As for claim 21, it's rejected for the same reason set forth in claims 11, 12 above. As for claim 22, it's rejected for the same reason set forth in claims 15-16 above.

Alternatively, the adjusting of these business parameters as shown in claims 11-14, 17, 19-22 are considered as optimizing operating conditions or result effective variables and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan. In re Aller, 105 USPQ 233.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 6,219,654 is cited to teach a performing cost analysis of an information technology implementation.

2) US 2001/0049595 is cited to show a system and method for enterprise modeling, optimization and control.

3) NPL:

1) Article "Business Insight" discloses a business software that allows user to enter data in a question-and-answer format and analyzing the proposed business scenario automatically using a true expert system. This reference could have been used for rejection, but to avoid duplicate rejection, it's cited here for applicant's awareness of well known problem solving techniques.

2) Article "Expert Systems in Marketing: Current trends and an Alternative Scenario" discloses a business software that allows user to enter data in a question-and-answer format and analyzing the proposed business scenario automatically using an expert system. This reference could have been used for rejection, but to avoid duplicate rejection, it's cited here for applicant's awareness of well known problem solving techniques.

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10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113. Applicant can also review the status of the application from the Patent Application Information Retrieve (PAIR) system, see <http://pair-direct.uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053, personal Right Fax at (703) 872-9674. My work schedule is normally Monday through Friday from 6:30 am through 4:00 pm with every 1st Friday of the bi-week off.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9327. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtm
March 2, 2004


DEAN T. NGUYEN
PRIMARY EXAMINER